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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,194	01/28/1999	JOHN S YATES JR.	5231.5-4013	9716

7590

01/14/2003

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EXAMINER

BANANKHAH, MAJID A

ART UNIT	PAPER NUMBER
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2127

DATE MAILED: 01/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/239,194

Applicant(s)
John S. Yates Jr. et al.

Examiner
Majid Banankhah

Art Unit
2127



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 28, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-83 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. This office action is in response to paper number 9, "Response to Restriction Requirement", and Amendment A which was received October 28, 2002. In view of the Applicant's traversal argument and remarks presented on pages 2-12 the restriction requirement is hereby withdrawn. However, upon further review by the Examiner it has been determined that a new restriction requirement is necessary.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-78, and 82-83 drawn to a first type of processor to emulate and execute instructions associated with one or more different type of processor, classified in class 709, subclass 1.
- II. Claims 79-81, drawn to contained within one or more executable code libraries (e.g., Dynamic Linking library or DLL) are called as needed at runtime by one or more application program, classified in class 709, subclass 331.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I, and II are related as combination and sub-combination (AB broad and B specific).

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Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and (2) that the sub-combination has utility by itself or in other combinations (MEP. § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed because system of claims 1-78 and 82-83 does not need the particulars of the link libraries and links between calls in the application and functions in the DLL at the runtime. In other words, a virtual machine which emulate another environment, and accommodating addressing requirements for software emulation of a target computer or digital data processing system does not need the detail of linking and link between calls in the application and functions to be resolved at runtime. In the dynamic Link Library and late binding, multiple application may reference a single dynamic library which eliminate redundant code and result in a more modular system. Therefore the sub-combination 79-81 has a separate utility as stated above. Since claims to both the sub-combination (79) and combination (1, 5, 33, and 56) are presented and assumed to be patentable, the omission of details of the claimed sub-combination (claim 79) in the combination (claims 1, 5, 33, 56) is evidence that the patentability of the combination

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does not rely on the details of the specific combination.

4. Applicant is advised that the response to this requirement to be complete **must include an election of the invention to be examined even though the requirement be traversed.**

A *shortened statutory period* for response to this office action is set to expire **ONE MONTH**. Or thirty days, whichever is longer, from the mailing date of this communication. (35 U.S.C. § 133). Extensions of time may be obtained under the provision of 37 CFR 1.136(a).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Maid A. Banankhah** whose voice telephone number is (703) 308-6903. A voice mail service is also available at this number.

All response sent to U.S. Mail should be mailed to:
Commissioner of Patent and Trademarks
Washington, D.C. 20231. Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington. VA, Six Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses to the Examiner. **All Formal or Official**

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Faxes must be signed and sent to either (703) 308-9051 or (703) 308-9052. Official faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the office, e.g., Finance Division for fee charging, etc.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Maid Banankhah

January 13, 2003

